

REMARKS

The Final Office Action dated 8/16/2007 has been reviewed, and the comments of the U.S. Patent Office have been considered. Claims 28-47 are pending, claims 1-27 having been previously canceled. Claims 29, 34, 40, and 45 have been amended.

First, the Office Action states that

Recitations of “such that blood can leave the headspace through the first opening while fluid is simultaneously injected into the headspace through the second opening” in claim 36 and “such that blood can leave the headspace through the first opening while fluid is simultaneously injected into the headspace through the second opening, and the fluid is thoroughly mixed with the blood before the blood leaves the headspace” in claim 37 and “such that blood is able to leave the outlet headspace while fluid is simultaneously injected into the outlet headspace”

Applicants traverse the rejection. The recitation is not intended use as the Examiner suggests. Functional recitation proper. See MPEP 2114, which states that functional language is acceptable if “distinguishes from the prior art in terms of structure.” In the above recitation, “such that blood can leave the headspace through the first opening while fluid is simultaneously injected into the headspace through the second opening” distinguishes the prior art of Mathieu, where both the first opening (3a) and the secondary port (12) are merged before they access the headspace 9. limiting. MPEP §2173.05(g) contains examples which are completely analogous and found to be perfectly acceptable. For example, the recitation in a claim of “portions. . . being resiliently dilatable whereby said housing may be slidably positioned” was found to be acceptable. The recitation does not require that the recited portions are dilated or even subject to a force. The recitation characterize the structure in terms of how it would behave if subjected to a force to dilate it just as the instant recitation describes how the structure of the claim would behave if fluids were injected. In fact, recitation of “such that . . .” combined with a function is such a commonplace in patent practice that the issue seems well settled. Thus, the functional language defines structure and also the defined structure distinguishes the prior art structure.

The other quoted recitations also recite structure in the same sense and also distinguish the prior art, the Mathieu structure being incapable of providing the recited function.

The Office Action states that

Mathieu is silent as to the distance between the media and the outlet cap. A device having the claimed relative dimensions of the headspace by the distance between the media and the outlet cap would not perform differently than the device of Mathieu and the claimed device is not patentably distinct from the prior art device.

Applicants respectfully disagree. The size of the headspace does affect the flow of fluid therein and in particular is significant in terms of the prevention of flow stagnation that can cause blood clots. So Applicants disagree with the Examiner's statement that the claimed invention "would not perform differently than the device of Mathieu."

The Office Action also states,

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the filter apparatus of Mathieu to provide direct connection of the dilution inlet to the secondary outlet port in the outlet headspace in addition to blood outlet port for mixing of gas with liquid to gasify the liquid with oxygen as suggested by Mathieu (see col. 5, lines 11-20), since it has been held that rearranging parts of an invention involves only routine skill in the art.

"Use of per se rules by Office personnel is improper for determining whether claimed subject matter would have been obvious under 35 U.S.C. 103" MPEP 2411.089. Applicants traverse the rejection. The MPEP states that the Examiner may use the rationale used by the court "if the facts in a prior legal decision are sufficiently similar to those in an application under examination. In the present case, the facts are not even analogous. The holding in *In re Japikse* is based on the fact that "shifting the position of the starting switch would not have modified the operation of the device." The location of the switch was found to be immaterial. The proposed modification of Mathieu produces a result with significantly different properties because the

claimed features permit injected through one port to mix the fluid in the head space while the structure of Mathieu does not.

For all the foregoing reasons, Applicants submit that the Examiner has not made a *prima facie* showing of obviousness and the claims, therefore, have been improperly rejected.


CONCLUSION

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the undersigned to expedite prosecution of the application.

The Commissioner is hereby authorized by this paper to charge any fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-3840. **This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).**

Respectfully submitted,

Date: October 15, 2007
Patent Administrator
Proskauer Rose LLP
1001 Pennsylvania Avenue, NW
Suite 400
Washington, DC 20004
Telephone: 202.416.6800
Facsimile: 202.416.6899



Mark A. Catan
Attorney for Applicant
Reg. No.: 38,720

Customer No. 61263